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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,669	10/23/2003	Matthew Lerner	003797.00675	5871
28319 7590 04/18/2007 BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER RUTLEDGE, AMELIA L	
			ART UNIT 2176	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/690,669	Applicant(s) LERNER ET AL.	
	Examiner Amelia Rutledge	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,11-13,21,24,26,27,35,38 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,11-13,21,24,26,27,35,38 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 01/13/2007.
2. Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40-44 are pending in the case.
Claims 1, 13, 27, 41, and 43 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Moran, U.S. Patent No. 6,509,912, issued January 2003.**

Regarding independent claim 1, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object. Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as part of a file or document

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save operation because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), therefore Moran inherently discloses that the domain objects, i.e., property values may be received as part of a file or document save operations. Compare to claim 1, *an input system that receives in electronic ink format a property value of a document or file on or accessible by the computer system as part of a file or document save operation.*

Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 1, *a storage system that stores the property value of the document or file in electronic ink format; and an ink access system that allows the operating system to access the stored property value in electronic ink format; and a rendering system for rendering the stored property value in electronic ink format.*

Moran teaches that the property value in electronic ink format includes an electronic ink title for the document or file (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), and that the title may be rendered as part of a file list operation (col. 10, l. 60-col. 11, l. 31). Moran teaches that the title may be rendered as part of a file preview operation (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview.

Regarding dependent claim 8, Moran teaches that the input system is activated in response to a command from an application program requesting activation of

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electronic ink input with respect to at least one document or file in the application program, since Moran teaches that the freeform editing program requests activation of electronic ink input with respect to documents or files in the program (col. 6, l. 20-col. 7, l. 25).

Regarding dependent claims 11 and 12, Moran teaches that the input system receives from a user a change to the property value in electronic ink format associated with the document or file (col. 13, l. 13-col. 14, l. 23; claim 1), and that the property value in electronic ink format includes an electronic ink title (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60).

Regarding independent claim 13, claim 13 reflects the methods implemented by the system as claimed in claim 1, and is rejected along the same rationale.

Regarding dependent claim 21, 24, and 26, claims 21, 24, and 26 reflect the methods implemented by the system as claimed in claims 8, 11, and 12, respectively, and are rejected along the same rationale.

Regarding independent claim 27, claim 27 reflects the computer-readable medium including computer-executable instructions used by the system as claimed in claims 1, 8, and 9, and is rejected along the same rationale.

Regarding dependent claims 35, 38, and 40, claims 35, 38, and 40 reflect the computer-readable medium including computer-executable instructions implemented by the system claimed in claims 8, 11, and 12, respectively, and are rejected along the same rationale.

Regarding independent claim 41, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object. Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as a command because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), compare to claim 41, *sending a command from an application program to an operating system, wherein the command requests activation of an electronic ink entry region for changing a property value stored in electronic ink format of a document or file on the application program.* Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 41, *receiving the command in the operating system; sending a user interface including the electronic ink entry region to the application program.* Moran teaches displaying the user interface including the

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electronic ink entry region with the property value in electronic ink format, the electronic ink entry region adapted to receive electronic ink input to change the property value stored in electronic ink format of the document or file (Col. 8, l. 24-61; Fig. 12).

Regarding dependent claim 42, Moran teaches that the command is sent from the application program to the operating system as part of a call requesting return of the user interface and activation of a process for changing the property value stored in electronic ink format of the document or file present on the application program, since Moran teaches calls requesting return of the user interface and activation of a process for changing the property value sent from the application program to the database and operating system (col. 6, l. 20-col. 7, l. 25).

Regarding independent claim 43 and dependent claim 44, claims 43 and 44 reflect the computer readable medium including computer executable instructions used for implementing the methods as claimed in claims 41 and 42, and are rejected along the same rationale.

Response to Arguments

Applicants' arguments filed 01/31/2007 have been fully considered but they are not persuasive. While applicants argue that the claimed "property value" (Claim 13, l. 2), is not equivalent to the domain objects disclosed by Moran (Remarks, p. 6-7), it is respectfully noted that the term "property value" is not defined anywhere in the

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Specification, and the word "property" is used twice in the specification in two different contexts, therefore the claimed term must be interpreted. The claims must be given the broadest reasonable interpretation in light of the specification.

MPEP 2106 cites (emphasis added):

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

If the applicant asserts that a term has a meaning that conflicts with the term's art-accepted meaning, USPTO personnel should encourage the applicant to amend the claim to better reflect what applicant intends to claim as the invention. If the application becomes a patent, it becomes prior art against subsequent applications. Therefore, it is important for later search purposes to have the patentee employ commonly accepted terminology, particularly for searching text-searchable databases.

In this case, it is the examiner's opinion that as claimed, the scope of claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40-44 is sufficiently broad that each and every limitation of the claimed invention is disclosed by Moran, and therefore the claim rejections should be maintained. It is the examiners opinion that the domain objects disclosed by Moran are programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1).

While applicants argue that display of the attribute value is not part of a document object preview operation (Remarks, p. 7), the examiner disagrees. A "preview" operation is not defined anywhere in applicants' Specification, however, the Specification does list view operations of files with ink titles (Specification, p. 25, par. 73), which are equivalent to the operations disclosed by Moran and discussed in the rejections of claim 1, above.

In response to applicants' arguments regarding independent claim 41 (Remarks, p. 8), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR



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